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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,820	09/12/2003	Huy D. Phan	2024729-7032372001	7044

7590 01/24/2006

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EXAMINER

VRETTAKOS, PETER J

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/660,820	Applicant(s) PHAN ET AL.	
	Examiner Peter J. Vrettakos	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11-7-05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-5-03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is **final**. **Claims 1-21 are rejected**. Pending claims are 1-21.

Independent claims are 1 and 19.

The application is published application number: 2005/0059962.

The Applicant is requested to check the beginning of the Specification with the Bib Data Sheet to ensure that the two lists the same priority information.

**The IDS dated 12-5-03 is considered.**

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 10, 12-15 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Greene et al. (4,913,164).

Greene discloses a method and medical probe/ catheter (col. 2:2 and col. 4:9) comprising

- an elongate member (80 or 36),
- an ablative element/electrode (consists of 40 + 46 + 42 in figure 6; col. 8:26-37),

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a non-conductive (col. 6:20-24) **protective element (14 in figure 1, 24 in figure 4) that partially covers the ablative element from contacting solid tissue (see figure 6 where element 56 – analogous to 14 – overlaps/blocks ablative element 46)** comprising a cage assembly (figure 4, 30 + 32 + 24 + 26) with struts (30), a coaxial ring element (attached to numeral 24 in figure 4), and a fixed attachment (32, figure 4), and

a sleeve (38, figure 6), and

a handle (inherent) with steering mechanisms (stylets 80 and 36).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 9, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene et al. in view of King et al. (6,161,047).

Greene neglects to expressly disclose a collapsed protective element that rests inside a sleeved lumen.

King discloses numerous devices analogous to Greene (electrode device with distal outer protective collapsible mechanisms), which depict collapsed protective element that rest inside sleeved lumens (see figure 10a, 500 is protective mechanism, 20, is elongate member, 510 is ablation element, 14 is

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sleeved lumen). Further, King discloses a cage assembly (figure 8b, 822 + 824 + 820) with a proximal ring element (832) and a fixed distal element (830). Lastly, King discloses in figure 8b numerous ablation elements (808, 809, 810) covered (in a collapsed configuration) by the cage assembly (820 + 822), as well as an additional protective element (500) another embodiment in figures 10a and 10b, which also has an additional ablation element (510).

Therefore, at the time of the embodiment it would have been obvious to one of ordinary skill in the art to modify Greene in view of King by including different design configurations into the Greene device. The motivation would be to increase the applicability of the Greene device. (King actually discusses structural limitations of prior art devices similar to Greene's, in the context that more flexibility in design is warranted in the art, thereby warranted the numerous embodiments in King.)

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greene et al. in view of Greene in view of Mest et al. (6,405,067).

Greene neglects to disclose **braided** polyurethane as a constituent of the protective member. (Greene does disclose polyurethane as a constituent of the protective member.)

Mest in a device analogous to Greene disclose tubular braided polyurethane (col. 5:23-28).

Therefore, at the time of the embodiment it would have been obvious to one of ordinary skill in the art to modify Greene in view of Mest by including

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disclose **braided** polyurethane as a constituent of the protective member. The motivation would be to increase the strength of the material as inferred in Mest col. 5:26.

### ***Response to Arguments***

Applicant's arguments filed 11-4-05 have been fully considered but they are not persuasive. Element 14/56 in Greene 4,913,164 indeed "at least partially covers the ablative element (46) from contacting solid tissue" as seen in figure 6. Simply by overlapping the electrode/ablative element, Greene's 56 prevents the ablative element (46) from contacting solid tissue. Note that element 14/56 is suggestively made of insulating material (polyurethane or silicon rubber, col. 6:20-25).

Further, the Applicant's arguments regarding the Greene electrode being designed to come into contact with tissue is directed toward the intended use of the device, which carries little patentable weight in apparatus/device claims. The Greene collar as mentioned above is inherently capable of maintaining a spacing with tissue.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Pete Vrettakos  
January 14, 2006



MICHAEL PEFFLEY  
PRIMARY EXAMINER